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ROPES & GRAY LLP
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OFFICE OF PETITIONS

In re Application of :
Burkly et al. : DECISION ON APPLICATION
Application No. 09/804,490 : FOR
Filed: March 12, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. CIBT-P01-114 :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT," filed July 21, 2008. Applicants request that the initial determination of patent term adjustment be corrected from two hundred seventy-eight (278) days to five hundred ten (510) days.

The request for correction of the initial determination of patent term adjustment (PTA) is **GRANTED to the extent indicated herein.**

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment determination at the time of the mailing of the Notice of Allowance is FOUR HUNDRED SIXTY-TWO (462) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On April 18, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 278 days. On July 21, 2008, applicants timely¹ submitted an application for patent term adjustment (with required fee). Applicants request correction of the PTA to 510 days.

Applicants state that this patent is not subject to a terminal disclaimer.

¹ The Issue Fee payment was also received on July 21, 2008.

Applicants' bases for correction of the patent term adjustment have been considered and found persuasive to an extent. Applicants are correct that the patent term adjustment should be reduced:

- by 56 days, pursuant to 37 CFR 1.704(b), for the RCE filed August 4, 2005. A period of reduction of 56 days has been entered;
- pursuant to 37 CFR 1.704(c)(8), for the filing of a supplemental response, not requested by the examiner, on January 11, 2008. However, the period of reduction is 29 days (not 28 days), beginning on December 14, 2007 and ending on January 11, 2008 and is being entered;
- pursuant to 37 CFR 1.704(c)(8), for the filing of a supplemental response, not requested by the examiner, on March 5, 2008. The response, an IDS, did not include a § 1.704(d) statement. However, the period of reduction is 54 days (not 53 days) beginning on January 12, 2008 and ending on March 5, 2008 and is being entered.

Further, a review of applicants' response filed May 27, 2004 shows that applicants established by *prima facie* evidence in the form of a date-stamped return postcard that the response was originally filed on October 27, 2003. This was within three months of the mailing of the restriction requirement on October 2, 2003. Thus, with respect to responding to the restriction requirement, applicants did not fail to engage in reasonable efforts to conclude processing or examination within the meaning of 37 CFR 1.704(b). Accordingly, the period of reduction of 130 days is being removed.

Furthermore, given that the response was filed on October 27, 2003, applicants are entitled to a period of adjustment for Office delay. The Office did not mail an action in response until September 7, 2004, four months and 193 days later. Accordingly, a period of adjustment of 193 days for Office delay is being entered.

However, consideration of any period of reduction for applicants' filing of an amendment on June 5, 2008 after the mailing of the notice of allowance on April 18, 2008 is premature. The revised patent term adjustment indicated on the patent will include any period of reduction warranted pursuant to 37 CFR 1.704(c)(10) for the filing of this amendment. If


not, applicants should timely file a letter pursuant to their duty of good faith and candor to the Office.

In view thereof, the correct determination of PTA at the time of the mailing of the notice of allowance is FOUR HUNDRED SIXTY-TWO (462) days (508 + 193 + 39 days for Office delay minus 2 + 56 + 62 + 41 + 34 + 29 + 54 days for applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the application. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of adjusted PALM calculation

PTA Calculations for Application: 09/804490

Application Filing Date:	03/12/2001	PTO Delay (PTO):	547
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	269
Post-Issue Petitions:	0	Total PTA (days):	462
PTO Delay Adjustment:	184		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
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105	09/05/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	193		
104	09/05/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	130		
103	09/05/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		29	
102	09/05/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		54	
90	04/18/2008	MAIL NOTICE OF ALLOWANCE			
89	04/16/2008	ISSUE REVISION COMPLETED			
88	04/16/2008	DOCUMENT VERIFICATION			
87	04/16/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
86	04/11/2008	NOTICE OF ALLOWABILITY			
82	12/13/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
81	03/05/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
80	03/05/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
79	12/13/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
78	03/06/2008	DATE FORWARDED TO EXAMINER			
77	01/11/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
76	03/06/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
74	01/07/2008	SEQUENCE FORWARDED TO PUBS ON TAPE			
73	12/17/2007	EXPORT TO INITIAL DATA CAPTURE			
72	12/13/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
71	12/13/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			

70	11/07/2007	MAIL NOTICE OF ALLOWANCE	39		62
69	09/28/2007	ISSUE REVISION COMPLETED			
68	09/28/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
67	09/28/2007	CASE DOCKETED TO EXAMINER IN GAU			
66	09/28/2007	DOCUMENT VERIFICATION			
65	09/28/2007	NOTICE OF ALLOWABILITY			
64	09/19/2007	CASE DOCKETED TO EXAMINER IN GAU			
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60	01/25/2007	MAIL NON-FINAL REJECTION			
59	01/22/2007	NON-FINAL REJECTION			
58	11/07/2006	DATE FORWARDED TO EXAMINER			
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55	06/16/2006	MAIL NON-FINAL REJECTION			
54	06/12/2006	NON-FINAL REJECTION			
53	03/29/2006	DATE FORWARDED TO EXAMINER			
52	03/22/2006	RESPONSE AFTER NON-FINAL ACTION		62	49
51	03/22/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
50	03/22/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
49	10/19/2005	MAIL NON-FINAL REJECTION			
48	10/17/2005	NON-FINAL REJECTION			
47	08/10/2005	DATE FORWARDED TO EXAMINER			
46	08/04/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
45	08/10/2005	DATE FORWARDED TO EXAMINER			
44	08/04/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
43	08/10/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
42	08/04/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
41	08/04/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
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34	12/09/2004	WORKFLOW INCOMING AMENDMENT IFW			
33	09/07/2004	MAIL NON-FINAL REJECTION			
32	09/03/2004	NON-FINAL REJECTION			
31	05/27/2004	MISCELLANEOUS INCOMING LETTER			
30	06/28/2004	DATE FORWARDED TO EXAMINER			
29	05/11/2004	RESPONSE TO ELECTION / RESTRICTION FILED		130	24
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27	05/14/2004	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
26	05/11/2004	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
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24	10/02/2003	MAIL RESTRICTION REQUIREMENT	508		-1
23	10/01/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
22	05/05/2003	CASE DOCKETED TO EXAMINER IN GAU			
21	07/05/2002	PRELIMINARY AMENDMENT			
20.7	09/10/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
20	09/10/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
19	01/09/2003	APPLICATION IS NOW COMPLETE			
18	03/12/2001	ADDITIONAL APPLICATION FILING FEES			
17	03/12/2001	TRANSLATION OF CLAIMS INTO ENGLISH			
16	03/12/2001	CLAIM PRELIMINARY AMENDMENT			
15	06/28/2002	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
14	07/01/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
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6	09/27/2001	APPLICATION DISPATCHED FROM OIPE			
5	09/26/2001	APPLICATION IS NOW COMPLETE			
4	05/21/2001	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	05/21/2001	CORRESPONDENCE ADDRESS CHANGE			
2	04/09/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	03/12/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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